

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
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Hidenori Abe et al.)	Group Art Unit: 1624
)	
Application No.: 10/534,725)	Examiner: Noble E. Jarrell
)	
Filed: May 12, 2005)	
)	Confirmation No.: 7083
For: INDOLE DERIVATIVES AS)	
SOMATOSTATIN AGONISTS OR)	
ANTAGONISTS)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated October 2, 2007, the Examiner required
restriction under 35 U.S.C. § 121 between:

Group I - Claims 1-20, 22, 24, 26-27, drawn to compounds, compositions,
and methods of formula (I) where ring A is phenyl, variable B is an
alkyl chain with no heteroatoms embedded in the chain, and the
group represented by NR^1R^2 is an amino group that does not form
a ring with variables R^1 and R^2 .

Group II - Claims 1-20, 22, 24, 26-27, drawn to compounds, compositions,
and methods of formula (I) where ring A is phenyl, variable B is an

alkyl chain with no heteroatoms embedded in the chain, and the group represented by NR^1R^2 is a pyrrolidine ring.

Group III - Claims 1-20, 22, 24, 26-27, drawn to compounds, compositions, and methods of formula (I) where ring A is phenyl, variable B is an alkyl chain with no heteroatoms embedded in the chain, and the group represented by NR^1R^2 is a morpholine ring.

Group IV - Claims 1-20, 22, 24, 26-27, drawn to compounds, compositions, and methods of formula (I) where ring A is phenyl, variable B is an alkyl chain with no heteroatoms embedded in the chain, and the group represented by NR^1R^2 is a piperazine ring.

Group V - Claims 1-9, 11-20, 22, 24, 26-27, drawn to compounds, compositions, and methods of formula (I) where ring A is 1,3-thiazoline, variable B is an alkyl chain with no heteroatoms embedded in the chain, and the group represented by NR^1R^2 is an amino group that does not form a ring with variables R^1 and R^2 .

Group VI - Claims 1-20, 22, 24, 26-27, drawn to compounds, compositions, and methods of formula I where the combination of variables A, B and NR^1R^2 form a 1,2,3,4-tetrahydroisoquinoline ring.

Group VII - Claims 1-20, 22, 24, 26-27, drawn to compounds, compositions, and methods of formula I where the combination of variables A, B, and NR^1R^2 form an isoindoline ring.

Group VIII - Claims 1-20, 22, 24, 26-27, drawn to compounds, compositions, and methods of formula I where the combination of variables A, B and NR^1R^2 form a 2,3,4,5-tetrahydro-1H-benzo[d]azepine ring.

Group IX - Claims 1-20, 22, 24, 26-27, drawn to compounds of formula (I) that are not covered by groups I-VIII.

Group X - Claim 28, drawn to compounds encompassed by the structure shown in claim 28.

Applicants provisionally elect to prosecute Group I, Claims 1-20, 22, 24, 26-27, drawn to compounds, compositions, and methods of formula (I) where ring A is phenyl, variable B is an alkyl chain with no heteroatoms embedded in the chain, and the group represented by NR^1R^2 is an amino group that does not form a ring with variables R^1 and R^2 with traverse.

According to MPEP § 803, there are two requirements that must be met before a proper restriction requirement may be made: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. Applicants respectfully submit that the Office has failed to establish the second requirement set forth in MPEP § 803.

Applicants traverse on the ground that the Office has not made a persuasive showing that there would be an undue burden in examining the subject matter of all claims in a single application. The mere fact of separate classification no longer represents an adequate basis to conclude that an undue burden exists given the electronic search tools available to examiners.

It is therefore respectfully requested that the restriction requirement be reconsidered and withdrawn. In the event that the restriction requirement is maintained, Applicants reserve the right to file divisional applications on the non-elected inventions and/or to request rejoinder of appropriate claims once the subject matter of claims 1-20, 22, 24, 26-27 is found allowable.

The Office further required an election of species. Applicants have elected the compound of Example 67 with traverse.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 1, 2007

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